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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,389	10/09/2001	Richard R. Herzog	8667-60	6166

7590 02/28/2002

Mr. John P. O'Brien
Group Technology Counsel
ILLINOIS TOOL WORKS INC.
3600 West Lake Avenue
Glenview, IL 60025-5811

EXAMINER

HARRIS, ERICA B

ART UNIT

PAPER NUMBER

3634

DATE MAILED: 02/28/2002

Please find below and/or attached an Office communication concerning this application or proceeding.



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Office Action Summary

Application No.

09/973,389

Applicant(s)

HERZOG ET AL.

Examiner

Erica B Harris

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 15-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15, 16, 18, 21 and 27-34 is/are rejected.
- 7) ☒ Claim(s) 17, 19, 20 and 22-26 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Misnumbered claims 34-47 have been renumbered 21-34.

2. Claims 27, 28, and 32 are objected to because of the following informalities:

in claim 27, line 1, "flex-limited latching locking latch" should be --flex-limited,
latching, locking latch--;

in claim 28, line 1, "The latch o Claim" should be --The latch of Claim--;

in claim 32, line 1, "flex-limited latching locking latch" should be --flex-limited,
latching, locking latch--;

line 5, "and" should be deleted;

line 7, --and-- should be inserted after "is coupled;"; and

line 10, "a portion of the flex limiting member disposable in the
recess" should be --wherein a portion of the flex limiting member is
disposable in the recess--.

Appropriate correction is required.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 27-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

5. In claims 27 and 32, the preamble only sets forth a “flex-limited latching locking latch,” but in line 2 of each claim a “flange” is set forth. According to the disclosure, the flange is not a part, per se, of the “latch”, rather it is a structure to which the latch is attached. It appears that applicant should be claiming the combination of the latch and a beam flange.

6. Claim 27 recites the limitation "the resilient arm" in line 4. There is insufficient antecedent basis for this limitation in the claim. It appears that “resilient” should be --flexible-- to correspond to line 3.

7. Claim 32 recites the limitation "the resilient arm" in line 4. There is insufficient antecedent basis for this limitation in the claim. It appears that “resilient” should be --flexible-- to correspond to line 3.

Double Patenting

8. Claims 27-34 of this application conflict with claims 30, 31, 33-35, and 37 of Application No. 09/693,045. 37 CFR 1.78(b) provides that when two or more applications filed by the same applicant contain conflicting claims, elimination of such claims from all but one application may be required in the absence of good and sufficient reason for their retention during pendency in

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more than one application. Applicant is required to either cancel the conflicting claims from all but one application or maintain a clear line of demarcation between the applications. See MPEP § 822.

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 27-34 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 30, 31, 33-35, and 37 of copending Application No. 09/693,045. Although the conflicting claims are not identical, they are not patentably distinct from each other because the cited claims of the instant invention are merely broader recitations of the limitations set forth in the cited claims of the co-pending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

12. Claims 15, 16, 21, and 27-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Olsson et al. (6,230,910 B1). In Figures 1 and 4-7, Olsson discloses a storage rack system 10 comprising a post 14 having a plurality of openings 18; a beam member 12 having a beam flange 36 with inner and outer sides and first and second openings, a headed lug 39 protruding from the inner side of the beam flange, the head lug disposable in an opening of the post to connect the beam member to the post; a locking pin opening 37 in the beam flange, the locking pin opening aligned at least partially with one of said openings in the post when the beam member is connected to the post; a flange recess 59 on the inner side of the beam flange; and a latch 45 coupled to the beam flange. The latch has an assembly aperture therethrough (headed lug 39 passes therethrough, Figure 5) aligned at least partially with one of the first and second openings of the beam flange and a resilient arm on the outer side of the beam flange with a locking pin 53 extending therefrom. The resilient arm 45 biases the locking pin 53 to protrude through the locking pin opening 37 of the beam flange 36 and at least partially into an opening 18 of the post 14 aligned with the locking pin opening when the beam member 12 is connected to the post. A locking flange 56 extends generally radially from the end of the shaft 51 of the locking pin 53. the locking pin is adjacent the locking flange recess 59 such that the locking flange is engagable with the flange recess to limit flexing of the resilient arm as the locking pin is withdrawn from the locking pin opening. The headed lug 39 includes a lug flange 42 extending radially from a

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side portion thereof, the locking flange 56 extends generally in the same direction as the lug flange.

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Olsson et al. as applied to claims 15, 16, 21, and 27-34 above, and further in view of Watanabe (5,862,024).

Olsson discloses all of the limitations of this claim except that the locking flange comprises first and second lobes that extend from opposing sides of said locking pin. Watanabe, in Figures 1a-3b, demonstrates a locking pin structure 4 that has first and second lobes 42,44 extending from opposing sides thereof. To one of ordinary skill in the art at the time the invention was made, it would have been obvious to construct the locking flange of Olsson et al. of two lobes, as taught by Watanabe, in order to make the interaction between said locking flange and said post stronger by enabling the engagement of a greater amount of surface area within said post by said locking flange.

Allowable Subject Matter

15. Claims 17, 19, 20, and 22-26 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

16. The following is a statement of reasons for the indication of allowable subject matter: These claims have been found to be allowable over the prior art of record because the prior art of record neither teaches nor suggests a storage rack system wherein a beam flange has latch that comprises a resilient arm with a locking pin attached thereto and protruding through an opening in said beam flange, said locking pin having a locking flange extending from the free end thereof; and including a tooth protruding from an end portion of said flange such that said locking flange and tooth are angled toward and extend toward the resilient arm of said latch (claims 17 and 22); wherein the resilient arm has a plurality of protrusions extending from the same side of the resilient arm as the locking pin (claim 20) and first and second legs protruding from an end portion thereof, each leg having a wing member extending outwardly away from the wing member of the other leg and generally parallel to the resilient arm (claim 19) . While storage rack systems with beam flanges and locking pins with locking flanges per se are revealed by King and Olsson et al., there is no teaching or suggestion for a person of ordinary skill in the art to combine the prior art teachings in the manner required by the claims to achieve the applicant's invention absent the applicant's own disclosure.

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Response to Arguments

17. Applicant's arguments with respect to claim 15 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Erica B Harris whose telephone number is 703-306-9071. The examiner can normally be reached on 9-5:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P Stodola can be reached on 703-308-2686. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3597 for regular communications and 703-305-3597 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

Erica B. Harris

Erica B. Harris
December 17, 2001

Daniel P Stodola

DANIEL P. STODOLA
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 3600